

DETAILED ACTION

Applicant claims benefit of a 371 of PCT/US04/14242, filed on 05/06/2004, which claims benefit of 60/468,222, filed on 05/06/2003. The benefit of earlier filing date is granted, because all the requirements are met.

Applicant claims issuing a secondary card from the U.S. financial institution to a national located in the country regulated by OFAC, and billing a primary cardholder who is an American residence or U.S. citizen and relative of the secondary cardholder. The method and system of using primary/secondary card as described in applicant's claims is well known and widely used around the world. For example, primary cardholder applies a secondary card for his/her spouse or child. Primary cardholder's spouse or child then uses the secondary card for cash withdrawal or goods purchase, and primary cardholder is billed for the cash withdrawal or goods purchased with the secondary cards.

Examiner believes the only distinct feature in applicant's claims is the limitation of the cardholders, Wherein the primary cardholder is a American residence from the country regulated by OFAC or U.S. citizen having at least one relative who is a national located in the country regulated by OFAC, and the secondary cardholder is a national located in the country regulated by OFAC. Putting limitation on the users or cardholders does not have patentable weight nor make the present invention different from the prior arts.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1, 7, 13, and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant claims issuing a secondary card from the U.S. financial institution to a national located in the country regulated by OFAC, such as Cuba, and billing the primary cardholder who has an account at said U.S. financial institution any cash distributed to or goods purchased with any of the secondary cards. It is understood that the secondary cards are used in countries regulated by OFAC, and the cards mention in the claims are considered as credit card or debit card issued by U.S. financial institution. According Caribbean Update (Caribbean Update, Cuba, Maplewood: Feb 2003. Vol. 19, Iss. 1; pg 5, 5pgs), "U.S. citizens and permanent resident aliens are prohibited from using credit cards in Cuba. U.S. credit card companies do not accept vouchers from Cuba, and Cuban shops, hotels and other places of business do not accept U.S. credit cards. Neither personal checks nor travelers checks drawn on U.S. banks are accepted in Cuba (see page 8 of Caribbean Update)". Applicant does not provide specific methods to avoid current prohibition in order to enable the invention.

Claim Rejection – USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 5,953,710 to Fleming, in view of Jensen (“Bush plots a course for Cuba”, Holger Jense. Cincinnatic Post, Ohio: Jul 24, 2001. pg. 8.A).

As per claim 1, Fleming teaches a method for transferring funds from the United States to one or more nationals located in a country regulated by the Office of Foreign Assets Control (OFAC) of the U.S. Department of the Treasury using a primary/secondary card, comprising:

receiving an application for a primary card by a primary cardholder at a U.S. financial institution, the primary cardholder being an American resident from the country regulated by OFAC or a U.S. citizen having at least one relative who is a national located in the country regulated by OFAC (see column 1, line 15-20; Fleming's patent is a US patent, so we can safely assume the financial institution is a US financial institution and the primary user is a American resident or U.S. citizen; the identity of the cardholder has no patentable weight, anyone can apply for credit card or debit card);

issuing a secondary card from the U.S. financial institution to each national sponsored by the primary cardholder (see column 5, line 10-62; prior art teaches issuing a secondary card to primary cardholder's child, therefore, the secondary cardholder is the relative of the primary cardholder and sponsored by the primary cardholder; again, limiting the identity and location of the cardholder has no patentable weight; prior art even teaches the primary cardholder and secondary cardholder can have different mailing address, which supports the use of the secondary card in another country, see column 5, line 42-45);

providing a monetary limit on each secondary card (see column 13, line 32-26; Fleming teaches setting monetary limit on child's card, which is a secondary card; Fleming also teaches setting limit on both credit card and debit card); and

billing the primary cardholder for any cash distributed to or goods purchased with any of the secondary cards (see column 3, line 19-24, and line 51-52; prior art teaches billing parent, which is the primary cardholder, for child's purchase with the secondary card, which is cash distributed to or goods purchased with secondary card).

Examiner notes however, Fleming does not explicitly teach setting the monetary limit accordance with the regulations set by OFAC.

Jensen teaches setting the monetary limit of fund transferring to a country regulated by OFAC (see page 1, "Bush has ordered the Treasury Department's Office of Foreign Assets Control to hire additional personnel to monitor travel to Cuba and limit the amount of money Cuban exiles send home"). Moreover, applicant discloses in the background that there is a monetary limit for Cuban Americans who are U.S. residents or citizens to send up to \$300 every three months. The information discloses is the background section of the application is considered as prior art. It is obvious that a monetary limit on the secondary card is necessary in order to comply with the current law.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include providing a monetary limit on each secondary card in accordance with the regulations set by OFAC.

One of ordinary skill in the art would have been motivated to modify the reference in order to comply with the limit set by the current law and control the expense of secondary cardholder.

As per claim 3, Fleming does not teach receiving a remittance affidavit at the U.S. financial institution for each national that the primary cardholder intends to sponsor.

Applicant discloses in the background that "Cuban American must attest to the fact that the recipient of these funds is not a senior-level official of the Communist Party of the Republic of Cuba or a senior-level official of the government of Cuba. This assurance must be in the form of an affidavit signed by the Cuban American." The information discloses is the background section of the application is considered as prior art. It is obvious that receiving a remittance affidavit is necessary in order to comply with the current law.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include receiving a remittance affidavit at the U.S. financial institution for each national that the primary cardholder intends to sponsor.

One of ordinary skill in the art would have been motivated to modify the reference in order to comply with the current law.

As per claim 4, Fleming teaches further comprising issuing a primary card from the U.S. financial institution to the primary cardholder (see column 1, line 15-20; column 4, line 55-60; and column 5, line 40-63; prior art teaches that both parent/primary cardholder and child/secondary cardholder receive cards issued by U.S. financial institution).

As per claim 6, Fleming teaches further comprising billing the primary cardholder for any cash distributed to or goods purchased with the primary card (see column 3, line 22-24 and abstract; the parent, or primary card holder, is billed for any cash distrusted

to or goods purchased with both the primary card and the secondary card) .

As per claim 7, Fleming teaches a computer-implemented system for transferring funds from the United States to one or more nationals located in a country regulated by the Office of Foreign Assets Control (OFAC) of the U.S. Department of the Treasury using a primary/secondary card, the system comprising:

a memory configured to store instructions (see claim 28-38, prior art is also a computer-implemented system, and it is inherent that a computer-implemented system must have a memory configured to store instructions); and

a processor configured to execute instructions for (see claim 28-38):

receiving an application for a primary card by a primary cardholder at a U.S. financial institution, the primary cardholder being an American resident from the country regulated by OFAC or a U.S. citizen having at least one relative who is a national located in the country regulated by OFAC (see column 1, line 15-20; Fleming's patent is a US patent, so we can safely assume the financial institution is a US financial institution and the primary user is a American resident or U.S. citizen; the identity of the cardholder has no patentable weight, anyone can apply for credit card or debit card);

issuing a secondary card from the U.S. financial institution to each national sponsored by the primary cardholder (see column 5, line 10-62; prior art teaches issuing a secondary card to primary cardholder's child, therefore, the secondary cardholder is the relative of the primary cardholder and sponsored by the primary cardholder; again, limiting the identity and location of the cardholder has no patentable weight; prior art even teaches the primary cardholder and secondary cardholder can have different mailing address, which supports the use of the secondary card in another country, see column 5, line 42-45);

providing a monetary limit on each secondary card (see column 13, line 32-26; Fleming teaches setting monetary limit on child's card, which is a secondary card; Fleming also teaches setting limit on both credit card and debit card); and

billing the primary cardholder for any cash distributed to or goods purchased with any of the secondary cards (see column 3, line 19-24, and line 51-52; prior art teaches billing parent, which is the primary cardholder, for child's purchase with the secondary card, which is cash distributed to or goods purchased with secondary card).

Examiner notes however, Fleming does not explicitly teach setting the monetary limit accordance with the regulations set by OFAC.

Jensen teaches setting the monetary limit of fund transferring to a country regulated by OFAC (see page 1, "Bush has ordered the Treasury Department's Office of Foreign Assets Control to hire additional personnel to monitor travel to Cuba and limit the amount of money Cuban exiles send home"). Moreover, applicant discloses in the background that there is a monetary limit for Cuban Americans who are U.S. residents or citizens to send up to \$300 every three months. The information discloses is the background section of the application is considered as prior art. It is obvious that a monetary limit on the secondary card is necessary in order to comply with the current law.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include providing a monetary limit on each secondary card in accordance with the regulations set by OFAC.

One of ordinary skill in the art would have been motivated to modify the reference in order to comply with the limit set by the current law and control the expense of secondary cardholder.

Claim 9 is rejected for the same reason as claim 3.

Claim 10 is rejected for the same reason as claim 4.

Claim 12 is rejected for the same reason as claim 6.

As per claim 13, Fleming teaches a computer-implemented method (see claim 28-38, prior art is also a computer-implemented method) for transferring funds from the United States to one or more nationals located in a country regulated by the Office of Foreign Assets Control (OFAC) of the U.S. Department of the Treasury using a primary/secondary card, comprising:

receiving an application for a primary card by a primary cardholder at a U.S. financial institution, the primary cardholder being an American resident from the country regulated by OFAC or a U.S. citizen having at least one relative who is a national located in the country regulated by OFAC (see column 1, line 15-20; Fleming's patent is a US patent, so we can safely assume the financial institution is a US financial institution and the primary user is a American resident or U.S. citizen; the identity of the cardholder has no patentable weight, anyone can apply for credit card or debit card);

issuing a secondary card from the U.S. financial institution to each national sponsored by the primary cardholder (see column 5, line 10-62; prior art teaches issuing a secondary card to primary cardholder's child, therefore, the secondary cardholder is the relative of the primary cardholder and sponsored by the primary cardholder; again, limiting the identity and location of the cardholder has no patentable weight; prior art even teaches the primary cardholder and secondary cardholder can have different mailing address, which supports the use of the secondary card in another country, see column 5, line 42-45);

providing a monetary limit on each secondary card (see column 13, line 32-26; Fleming teaches setting monetary limit on child's card, which is a secondary card; Fleming also teaches setting limit on both credit card and debit card); and

billing the primary cardholder for any cash distributed to or goods purchased with any of the secondary cards (see column 3, line 19-24, and line 51-52; prior art teaches billing parent, which is the primary cardholder, for child's purchase with the secondary card, which is cash distributed to or goods purchased with secondary card).

Examiner notes however, Fleming does not explicitly teach setting the monetary limit accordance with the regulations set by OFAC.

Jensen teaches setting the monetary limit of fund transferring to a country regulated by OFAC (see page 1, "Bush has ordered the Treasury Department's Office of Foreign Assets Control to hire additional personnel to monitor travel to Cuba and limit the amount of money Cuban exiles send home"). Moreover, applicant discloses in the background that there is a monetary limit for Cuban Americans who are U.S. residents or citizens to send up to \$300 every three months. The information disclosed in the background section of the application is considered as prior art. It is obvious that a monetary limit on the secondary card is necessary in order to comply with the current law.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include providing a monetary limit on each secondary card in accordance with the regulations set by OFAC.

One of ordinary skill in the art would have been motivated to modify the reference in order to comply with the limit set by the current law and control the expense of secondary cardholder.

Claim 15 is rejected for the same reason as claim 3.

Claim 16 is rejected for the same reason as claim 4.

Claim 18 is rejected for the same reason as claim 6.

As per claim 19, Fleming teaches a computer readable medium that stores instructions executable by at least one processor to perform a method for transferring funds (see claim 1-3, prior art is a computer-implemented method, which implies that instructions executable by at least one processor is stored in a computer readable medium) from the United States to one or more nationals located in a country regulated by the Office of Foreign Assets Control (OFAC) of the U.S. Department of the Treasury using a primary/secondary card, comprising instructions for:

receiving an application for a primary card by a primary cardholder at a U.S. financial institution, the primary cardholder being an American resident from the country regulated by OFAC or a U.S. citizen having at least one relative who is a national located in the country regulated by OFAC (see column 1, line 15-20; Fleming's patent is a US patent, so we can safely assume the financial institution is a US financial institution and the primary user is an American resident or U.S. citizen; the identity of the cardholder has no patentable weight, anyone can apply for credit card or debit card);

issuing a secondary card from the U.S. financial institution to each national sponsored by the primary cardholder (see column 5, line 10-62; prior art teaches issuing a secondary card to primary cardholder's child, therefore, the secondary cardholder is the relative of the primary cardholder and sponsored by the primary cardholder; again, limiting the identity and location of the cardholder has no patentable weight; prior art even teaches the primary cardholder and secondary cardholder can have different mailing address, which supports the use of the secondary card in another country, see column 5, line 42-45);

providing a monetary limit on each secondary card (see column 13, line 32-26; Fleming teaches setting monetary limit on child's card, which is a secondary card; Fleming also teaches setting limit on both credit card and debit card); and

billing the primary cardholder for any cash distributed to or goods purchased with any of the secondary cards (see column 3, line 19-24, and line 51-52; prior art teaches billing parent, which is the primary cardholder, for child's purchase with the secondary card, which is cash distributed to or goods purchased with secondary card).

Examiner notes however, Fleming does not explicitly teach setting the monetary limit accordance with the regulations set by OFAC.

Jensen teaches setting the monetary limit of fund transferring to a country regulated by OFAC (see page 1, "Bush has ordered the Treasury Department's Office of Foreign Assets Control to hire additional personnel to monitor travel to Cuba and limit the amount of money Cuban exiles send home"). Moreover, applicant discloses in the background that there is a monetary limit for Cuban Americans who are U.S. residents or citizens to send up to \$300 every three months. The information discloses is the background section of the application is considered as prior art. It is obvious that a monetary limit on the secondary card is necessary in order to comply with the current law.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include providing a monetary limit on each secondary card in accordance with the regulations set by OFAC.

One of ordinary skill in the art would have been motivated to modify the reference in order to comply with the limit set by the current law and control the expense of secondary cardholder.

Claim 21 is rejected for the same reason as claim 3.

Claim 22 is rejected for the same reason as claim 4.

Claim 24 is rejected for the same reason as claim 6.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 5,953,710 to Fleming, in view of Jensen ("Bush plots a course for Cuba", Holger Jense. Cincinnatic Post, Ohio: Jul 24, 2001. pg. 8.A), and further in view of Cohen (Pub. No.: US 2003/0097331)

As per claim 2, Fleming does not teaches wherein the step of providing a monetary limit comprises providing two or more monetary limits on each secondary

card, wherein a first monetary limit is set for one OFAC-regulated country and a second monetary limit is set for another OFAC-regulated country.

Cohen teaches providing two or more monetary limits on each secondary card (see paragraph 0202; a parent, or a primary cardholder, can assign different monetary limit on the secondary card).

Jensen teaches setting the monetary limit of fund transferring to a country regulated by OFAC (see page 1, "Bush has ordered the Treasury Department's Office of Foreign Assets Control to hire additional personnel to monitor travel to Cuba and limit the amount of money Cuban exiles send home"). Moreover, applicant discloses in the background that there is a monetary limit for Cuban Americans who are U.S. residents or citizens to send up to \$300 every three months, and there are several countries regulated by OFAC, such as Balks, Iran, and Iraq. It is obvious that OFAC would have different monetary limit on fund transfer to these countries. Therefore, setting up a first monetary limit for one OFAC-regulated country and setting up a second monetary limit for another OFAC-regulated country is necessary in order to comply with the current law.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the references to come up with the step of providing a monetary limit comprises providing two or more monetary limits on each secondary card, wherein a first monetary limit is set for one OFAC-regulated country and a second monetary limit is set for another OFAC-regulated country.

One of ordinary skill in the art would have been motivated to modify the reference in order to comply with the current law.

Claim 8 is rejected for the same reason as claim 2.

Claim 14 is rejected for the same reason as claim 2.

Claim 20 is rejected for the same reason as claim 2.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 5,953,710 to Fleming, in view of Jensen ("Bush plots a course for Cuba", Holger Jense. Cincinnatic Post, Ohio: Jul 24, 2001. pg. 8.A), and further in view of Official Notice.

As per claim 5, Fleming does not teach providing a monetary limit on the primary card in accordance with a credit rating of the primary cardholder.

Official Notice is taken that providing a monetary limit on the primary card in accordance with a credit rating of the primary cardholder is old and well known in the art. In fact, it has been widely used around the world.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include providing a monetary limit on the primary card in accordance with a credit rating of the primary cardholder.

One of ordinary skill in the art would have been motivated to modify the reference in order to limit the risk of default.

Claim 11 is rejected for the same reason as claim 5.

Claim 17 is rejected for the same reason as claim 5.

Claim 23 is rejected for the same reason as claim 5.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAO FU whose telephone number is (571)270-3441. The examiner can normally be reached on Mon-Fri/Mon-Thurs 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JAN-08